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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,909	12/22/2000	Lucy Broyles	4013-00100	4442
30652	7590	11/03/2005	EXAMINER	
CONLEY ROSE, P.C. 5700 GRANITE PARKWAY, SUITE 330 PLANO, TX 75024			GATES, ERIC ANDREW	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/747,909	Applicant(s) BROYLES, LUCY	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 and 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 and 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 6/10/05.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17, 23-27, 31-37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaton (2,694,264) in view of Gunter et al. (5,387,107).

Seaton discloses a process by which a reader facilitates the reading skills of a pre-reader (see column 1, lines 19-22) comprising the reader obtaining a repetitive language kit (10) having a theme ("illustrations of animals, houses, people, etc." – column 2, lines 1-4), the repetitive language kit comprising a plurality of pages (13) having binder and outer edges (as seen in figure 3), the plurality of pages including pages having indicia ("illustrations of animals, houses, people, etc." – column 2, lines 1-4); a binder (14) configured to secure the plurality of pages proximate the binder edges (as seen in figure 3); a photographic site configured to receive a pictorial representation (as seen in figure 3); a caption site (16) corresponding to the photographic site, the caption site configured to receive text (see column 2, lines 4-6); the reader sharing an experience (the parent reads the text while the child listens – see column 2, lines 9-11);

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and memorializing the shared story between the reader and the pre-reader through pictorial representations (as seen in figure 3).

Seaton discloses the claimed invention except for personalizing the repetitive language kit by affixing pictorial representations to corresponding photographic sites and adding text to the caption sites in an organized preferred order.

Gunter et al. disclose a storybook for teaching desired behavioral patterns having front and back covers and a plurality of pages therebetween. The covers and pages are bound together in a conventional manner. The pages have text printed thereon accompanied by an illustration relating to the theme of the storybook. The illustration may be personalized with the likeness of the reader by applying a photograph of the reader to the pages via adhesive or a transparent pocket (as seen in figures 5 and 6). The pages may be provided with an illustrative environment in which the personalized character interacts. Therefore, it would have been obvious to one skilled in the art to provide the book of Seaton with illustrations that may be affixed to the pages of the book, as taught by Gunter et al., to encourage enthusiasm from the pre-reader and to inspire the pre-reader to want to learn to read the book.

The kit having a theme related to a planned shared experience between the reader and the pre-reader sets forth the intended use of the kit. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 17, 23, 24, 31, 32, 34, 36-37, and 40-41, Seaton, as modified by Gunter et al., discloses the claimed invention except for the specific arrangement and/or content of indicia (repetitive text related to the theme of the planned shared experience between the reader and the pre-reader) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired text on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of text does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claims 25, 26, 35 and 36, Seaton, as modified by Gunter et al., discloses the claimed invention except for constructing a second personalized repetitive language book. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to provide any number of books to be read by the reader and the pre-reader, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 27 and 37, it is inherent that the reader and the pre-reader would be physically separated, since they comprise two different people.

Regarding claim 33, see the above rejections to claim 17.

4. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaton in view of Gunter et al. and further in view of Illos et al. ('738).

Seaton, as modified by Gunter et al., disclose the claimed invention except for the binder being selected from the group consisting of lace, ribbon, string and yarn, the binder being threaded through perforations of the front cover, back cover, and plurality of pages to form a plurality of loops proximate the front cover perforations and the ends being threaded through the loops for securing together.

Illos et al. disclose a tamper-proof page assembly comprising a plurality of pages (10) having a ribbon binder (16) for securing the pages together. Illos et al. show that ribbon is an equivalent structure for binding pages known in the art. Therefore, because these two binding structures were ad-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute ribbon, as taught by Illos et al., for the binding of Seaton.

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5. Claims 28-30, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaton in view of Gunter et al. and further in view of Phillips (5,651,678).

Seaton, as modified by Gunter et al., discloses the claimed invention except for explicitly disclosing the process of memorizing the text on the pages.

Phillips discloses an educational aid and method for using it to teach students to read by facilitating the rapid development of sight-word vocabularies in an interesting and challenging manner through the utilization of a student's natural ability to learn and memorize a text (see column 2, lines 39-42, 66-67 thorough column 3, lines 1-7).

Therefore, it would have been obvious to one having ordinary skill in the art of education to memorize text on pages, as taught by Phillips, to facilitate the instruction of students to read.

Response to Arguments

6. Applicant's arguments filed 10 June 2005 have been fully considered but they are not persuasive.

Applicant disagrees with the examiner's conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate.

In the present invention, the claimed repetitive language kit comprises a book having a binder for securing selected ones of a plurality of pages together. The invention comprises printed matter that has been printed onto a substrate where the

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printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the book of illustrations of Seaton in view of the interactive storybook of Gunter et al. is the same structure claimed by applicant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

The printed matter, therefore, has been considered; however, the examiner has determined that the claimed printed matter is not functionally related to the substrate, as stated above, and does not provide the functional relationship required for patentability.

For the reasons above, the grounds of rejection are deemed proper.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-5:15 & alt Fridays 7:45-4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EAG
24 October 2005

Eric A. Gates
Patent Examiner
Art Unit 3722



BOYER D. ASHLEY
PRIMARY EXAMINER